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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN D. DREHER

Appeal 2010-006829
Application 09/482,773
Technology Center 1600

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's rejection of claims 1-11 and 35.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Claims 1, 6, and 8 are representative of the claims on appeal, and read as follows:

1. A method of reducing the appearance of lines and wrinkles associated with aging of the skin, which comprises applying to the skin exhibiting the age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.
6. The method of claim 1 in which the composition further comprises at least one inorganic, non-matte, non-spherical powder in an amount in the range of from about 2 to about 10 percent by weight of the total composition.
8. The method of claim 1 in which the composition further comprises bismuth oxychloride.

The following grounds of rejection are before us for review:

- I. Claims 1-5, 7, 9, and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kimura² as evidenced by *Wrinkles and Wrinkle Treatments*.³
- II. Claims 1-7, 9-11, and 35 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Hineno⁴ and Kimura.

² Kimura, US 5,690,916, issued Nov. 25, 1997.

³ *Wrinkles and Wrinkle Treatments*, www.skincarereviews.com, printed on February 15, 2007.

⁴ Hineno, US 6,207,174 B1, issued Mar. 27, 2001.

- III. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Hinenno and Kimura as further combined with Hurst.⁵

We affirm.

ISSUE

Has the Examiner established by a preponderance of the evidence that the method taught by Kimura inherently anticipates the method of claim 1?

FINDINGS OF FACT

FF1 According to the Specification, “the invention relates to compositions that can enhance the facial appearance by diminishing the viewer’s ability to perceive fine lines and wrinkles on the face.” (Spec. 1.)

FF2 The Specification teaches:

The inevitable process of aging, whether chronological or UV-induced, strikes everyone, leaves the skin marked by a number of afflictions, the most noticeable of which start as fine lines and wrinkles, ultimately progressing to more discernable furrows and lines. The concern is not limited to the older person; even younger women now are more conscious of the early development of lines, which may result from excessive exposure to sun due to an active outdoor lifestyle.

(*Id.*)

FF3 The Specification teaches further that “[i]t has been unexpectedly discovered that the presence of an interference pigment having a blue or violet reflectance in a standard makeup composition, particularly a

⁵ Hurst et al., *Face Powders*, 116-121, in *POUCHER’S, PERFUMES, COSMETICS AND SOAPS, COSMETICS, VOLUME 3*, (Hilda Butler ed., 1993).

foundation, can create the illusion of substantially flawless skin, by ‘deceiving’ the observer’s eyes into not perceiving the lines and wrinkles that are actually present on the wearer’s skin.” (*Id.* at 2.)

FF4 As to the inclusion of an inorganic powder, the Specification teaches:

The composition also preferably contains an inorganic powder. It has been observed that, with the use of interference pigments producing only a blue or violet reflectance color in combination with metal oxides alone, these compositions do produce the desired reduction in appearance of fine lines and wrinkles, but it is an ‘all-or-nothing’ appearance: the viewer perceives the full benefit of the reflectance from the interference pigment when looking at the skin from the specular angle, or head-on; however, when the same skin is viewed at an incident angle, the reflectance from the interference layer is not visible, and only the pigment is seen. Thus, the transition between these two views is quite sharp, and therefore somewhat less than ideal. However, it has been unexpectedly discovered that the transition between viewing at specular and incident angles can be softened by the inclusion in the formula of an inorganic powders, such as a silica or polymethylmethacrylate. Although the powder can be any of the type ordinarily used in cosmetics, it is particularly preferred that the powder be a non-matte powders, in an amount of about 2 to about 10%.

(*Id.* at 4.)

FF5 The Examiner’s statement of the anticipation rejection may be found at pages 3-4 of the Answer. As Appellant states that the claims stand or fall together with respect to each ground of rejection (App. Br. 3), we focus our analysis on claim 1, and claims 2-5, 7, 9, and 11 stand or fall with that claim.

FF6 The Examiner finds, citing Example 13, that Kimura teaches “a foundation comprising 9.0 % by weight of blue interference pigment and

iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other noninterference inorganic pigments.” (Ans. 3.)

FF7 The Examiner also finds that “Kimura is directed to a treatment of various hyperpigmentation disorders including angioma, red face, spots, and freckles, which affect diverse racial groups.” (*Id.* at 8.)

FF8 Kimura “relates to skin-color adjusting method and composition by which a hyperchromic portion of the skin caused by nevus, angioma, red face, spots, freckles, and the like can become inconspicuous and a colored titanium oxide coated mica suitable for that composition, which has a transmitted light component with excellent dichroism and chroma.” (Kimura, col. 1, ll. 11-17.)

FF9 Citing *Wrinkles and Wrinkle Treatments*, the Examiner finds that the “claimed method of covering wrinkles of the skin as recited is inherently practiced by using the prior art composition, since wrinkles and lines are natural event and lines and wrinkles may be visible as early as 20-25 years of age.” (Ans. 3-4.)

FF10 Specifically, as taught by *Wrinkles and Wrinkle Treatments*, “certain inevitable problems happen,” one of which is wrinkles. (*Wrinkles and Wrinkle Treatments*, page 1 of 6.) Factors that can cause skin to wrinkle are sunlight and UV radiation from the sun, as well as smoking. (*Id.* at pages 2 and 3 of 6.)

FF11 Specifically, *Wrinkles and Wrinkle Treatments* teaches that as early as 20-25 years of age, vertical wrinkles on the forehead and between the eyebrows may become visible, and that from 25-35 wrinkles begin to deepen. (*Id.* at page 4 of 6) The reference teaches further that between 35-

50, deeper wrinkles occur, and laughter lines and crow's feet also deepen.

(*Id.*)

FF12 Thus, *Wrinkles and Wrinkle Treatments* teaches that the appearance of wrinkles and lines is an inevitable event, and lines and wrinkles may be visible as early as 20-25 years of age, but are clearly visible by 35 years of age.

PRINCIPLES OF LAW

It is hornbook law that merely recognizing something that was not known before is insufficient to render an old process again patentable. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1351 (Fed. Cir. 2002). *See also In re Woodruff*, 919 F.2d 1575 (Fed. Cir. 1990); *In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1373 (Fed. Cir. 2007).

In addition:

[A] prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. . . . Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.

MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

In *MEHL*, the patentee claimed a “method of hair depilation” utilizing steps which had been described in a prior art publication. The prior art method did not perform the steps for the purpose of hair depilation, but it was determined that hair depilation would have been a necessary, albeit unrecognized and inherent, consequence of carrying out the method. *MEHL*,

192 F.3d at 1366. Although the claim preamble expressly required the method to be performed for the purpose of hair depilation, the court did not find it necessary that the article's authors "appreciate the results" of their process to constitute an anticipation of the claimed process. (*Id.*).

Similarly, in *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1378-79 (Fed. Cir. 2005), a method claim preamble which required "preventing sunburn damage to exposed skin surfaces," was found satisfied by a prior art skin composition which had been applied to skin surfaces, but for a different purpose. "[T]he new realization alone [that the old composition would prevent sunburn damage] does not render the old invention patentable." *Perricone*, 432 F.3d at 1377.

ANALYSIS

Appellant argues that claim 1 has been amended to "make it clear that the makeup compositions comprising interference pigment having a blue or violet reflectance combined with at least one metal oxide are applied to skin exhibiting 'age-associated' lines and wrinkles.'" (App. Br. 5.) Appellant argues that Kimura does not anticipate the method of claim 1 because the reference "fails to explicitly or implicitly teach 'applying to the skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance combined with at least one metal oxide pigment.'" (*Id.*)

Appellant asserts that the populations to which the makeup composition of Kimura and that of the method of claim 1 are not necessarily the same, as Kimura teaches applying the composition "to blue discolored

skin in the lateral ocular area of an Asian female.” (*Id.*) Appellant asserts that merely because that step “might possibly also involve the application of the composition to age-wrinkled skin also is not adequate to support a rejection based on anticipation by inherency.” (*Id.* at 5-6.)

Appellant further asserts that it is well known that discoloration may occur in children, whose skin would not yet exhibit age associated wrinkles. (*Id.* at 6.) Appellant also argues that Asian women protect themselves from sunlight exposure, and thus “the so-called ‘normal progress of wrinkles by age group’ disclosed in ‘Wrinkles and Wrinkle Treatments’ is not necessarily, and in fact, is highly unlikely to be, applicable to the skin of Asian females, or therefore to all skins.” (*Id.*)

Appellant’s arguments have been carefully considered, but are not deemed to be convincing. First, while Appellant asserts that application of the foundation of Kimura to Ota’s nevus, which is a patch of blue discoloration, necessarily requires application to a female of Asian decent, Appellant has presented no evidence that Ota’s Nevus exclusively occurs in Asian females, and arguments of counsel cannot take the place of evidence in the record. *In re Scarbrough*, 500 F.2d 560, 566 (CCPA 1974).

Second, Appellant appears to be arguing that Asian females do not suffer from age-associated lines and wrinkles, but again, provides no evidence to support that assertion. In addition, both *Wrinkles and Wrinkle Treatments* and Appellant’s Specification teach that aging is an inevitable process. (See FF2 and FF10.) As *Wrinkles and Wrinkle Treatments* makes clear, it is not only UV exposure that causes age-associated lines and wrinkles, but it is the aging of the skin, and other factors may contribute to

the appearance of lines and wrinkles, which include not only exposure to sunlight, but also include factors such as smoking and air pollution. (*See Wrinkles and Wrinkle Treatments*, pages 2 and 3 of 6.)

Third, what is required by claim 1 is applying to skin exhibiting age-associated lines and wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment. Giving the claim its broadest reasonable interpretation, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (during ex parte prosecution, claims are to be given their broadest reasonable interpretation consistent with the description of the invention in the specification), the phrase “skin exhibiting age-associated lines and wrinkles” would encompass any level of age associated lines and wrinkles.

Thus, performance of the method of Kimura of applying, for example, the foundation of Example 13, to skin having blue pigmentation, if applied to skin of a person 25 years or older, one of ordinary skill would expect that the application would reasonably be to a person having at some level skin exhibiting age-associated lines and wrinkles. Such application would then inherently reduce the appearance of those lines and wrinkles, even though that result was *unrecognized* by Kimura.

For example, in *Perricone*, 432 F.3d at 1379, a claim to a method of preventing sunburn damage by topically applying a composition to exposed skin was found anticipated by a disclosure of a topical skin cream “[b]ecause all skin surfaces are susceptible to sunburn damage.” Anticipation was based the skin’s susceptibility to sunburn, not the requirement that, each time the prior art topical cream was applied to exposed skin, sunburn was

actually prevented. Likewise, we do not find it necessary that the appearance of age-associated lines and wrinkles be reduced in every case. It is enough that the aging process of skin is inevitable, making it certain that some people following Kimura's guidance would have inherently carried out the claimed method.

CONCLUSION OF LAW

We conclude that the Examiner has established by a preponderance of the evidence that the method taught by Kimura inherently anticipates the method of claim 1. We thus affirm the anticipation rejection as to claim 1. As claims 2-5, 7, 9, and 11 stand or fall with claim 1, we affirm the rejection as to those claims as well.

ISSUE (Obviousness)

Has Appellant presented evidence of unexpected results, such that when weighed with the evidence of obviousness, is sufficient to demonstrate the unobviousness of claims 6 and 7?

Has the Examiner demonstrated by a preponderance of the evidence that claim 8 is rendered obvious by the combination of Hineno, Kimura, and Hurst?

ADDITIONAL FINDINGS OF FACT

FF13 The Examiner's statement of the obviousness rejection over the combination of Hineno with Kimura may be found at pages 4-5 of the Answer. Again, we focus our analysis on claim 1 as Appellant states that

the claims stand or fall together as to each ground of rejection. (App. Br. 3.) We note further that the Appellant has presented separate arguments as to claims 6 and 7. (*See* App. Br. 10.)

FF14 The Examiner's statement of the obviousness rejection over the combination of Hineno, Kimura, and Hurst may be found at pages 5-6 of the Answer.

FF15 In addition, Kimura teaches that when a foundation sample according to the invention was applied to the skin,

not only was [it] excellent in covering blue hyperchromic portions of Ota's nevus or the like (i.e. in skin-color adjusting effect) but also yielded transparent feel and natural finishing. Also, when a commercially-available powdery foundation was applied after the application of this adjusting foundation, the gloss of titanium oxide coated mica changed into a natural transparent feel so as to yield a finishing feel which was comparable to the normal portion.

(Kimura, col. 20, ll. 31-39.)

FF16 The Examiner notes that Hineno and Kimura fail to specifically teach the use of bismuth oxychloride in the makeup composition. (Ans. 5.)

FF17 The Examiner finds that Hurst teaches that "bismuth oxychloride is the first synthetic pearlescent pigment . . . developed to provide an improved photosensitivity" and that pearlescent pigments may be used "to provide 'translucent luster, or frosted effect, to enhance the wearer's natural complexion.'" (*Id.* at 6 (citing Hurst, p. 117).)

FF18 Specifically, Hurst teaches that "pearlescent pigments belong to the interference category, although some combine interference with absorption." (Hurst, p. 116.) Hurst teaches further that the first synthetic pearlescent

pigment developed was bismuth oxychloride, followed by the micas. (*Id.* at 117.)

FF19 The Examiner concludes that it would have been obvious to add the bismuth oxychloride to the composition of Hineno and Kimura in order to obtain a makeup composition with a luster or frosted effect, enhancing the natural look of the user. (Ans. 6.)

PRINCIPLES OF LAW

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 416 (2007).

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417.

It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. *See also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of applicant’s invention. “A statement that a particular combination is not a preferred embodiment does not teach away

absent clear discouragement of that combination.” *Syntex (USA) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005) (citations deleted).

Moreover, it is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the Specification does not suffice. *In re DeBlauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

ANALYSIS

As to claims 1-7, 9-11, and 35, Appellant only argues claims 6 and 7⁶ separately. Thus, as to claims 1-5, 9-11, and 35, of which we choose claim 1 as representative, as we have already found that claim 1 is anticipated by Kimura, and as anticipation is the epitome of obviousness, *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002), we affirm the obviousness rejection as to claim 1.

As to claims 6 and 7, Appellant points to the paragraph bridging pages 4 and 5 of the Specification, arguing that they “have discovered that limiting the compositions of the invention to no greater than 15%, and preferably, to no greater than 10%, by weight of these inorganic powders, results in a more translucent, natural appearance to the skin, created by the softening of the transition angle,” as discussed in the Specification. (App. Br. 10.)

However, Appellant has presented no evidence of unexpected results, and the conclusory statements in the paragraph bridging pages 4-5 of the Specification (*see* FF) are not sufficient to demonstrate unexpected results.

⁶ Appellant also refers to claim 12 (App. Br. 10), which has been cancelled. (*See* App. Br. 2.)

As to claim 8, Appellant argues that Hurst does not remedy the deficiencies of Kimura and Hineno as applied to claim 1. (*See* App. Br. 12.) That argument is not found to be convincing for the reasons set forth above with respect to the analysis of the anticipation rejection of claim 1.

Appellant argues further that the ordinary artisan would not have added bismuth oxychloride to add luster as taught by Hurst, because Kimura teaches that “after the application to [the] skin of the composition containing the titanium dioxide coated mica (the interference pigment) a conventional foundation was applied so that the gloss of the titanium oxide coated mica was tempered or modulated to result in a natural transparent appearance so as to yield a finish which was comparable to the normal portion of the skin.” (App. Br. 12-13 (citing Kimura, col. 17, ll. 19-25; col. 20, ll. 34-39; and col. 22, ll. 18-23).) Appellant asserts that Kimura thus teaches that skin to which the composition containing the interference pigment “appeared undesirably glossy or lustrous,” and was “insufficiently natural-looking without covering the compositions further with a conventional foundation.” (App. Br. 13.)

Appellant’s arguments are not convincing. As noted by the Examiner, Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment, and may be used to enhance the wearer’s natural complexion. (FF17.) Thus, we agree with the Examiner it would have been obvious to combine it with the makeup composition containing the titanium dioxide coated mica interference pigment as taught by Kimura in order to enhance the wearer’s complexion. The fact that Kimura teaches adding another foundation does not reach the level of a teaching away because Kimura teaches that the composition containing the titanium dioxide coated mica

interference pigment yielded transparent feel and natural finishing before the addition of another foundation. (FF15.)

CONCLUSIONS OF LAW

We conclude that Appellant has not presented evidence of unexpected results, such that when weighed with the evidence of obviousness, is sufficient to demonstrate the unobviousness of claims 6 and 7. We thus affirm the obviousness rejection over the combination of Hineno and Kimura as to all of the claims.

We conclude further that the Examiner has demonstrated by a preponderance of the evidence that claim 8 is rendered obvious by the combination of Hineno, Kimura, and Hurst. We thus affirm the obviousness rejection as to claim 8 over that combination as well.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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